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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/467,706 | 12/20/1999 | PAT CONDON | DC-01916(163 | 2712 |

27683 7590 06/04/2003

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| EXAMINER |
|---|
| KEMPER, MELANIE A |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3622 | |

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/467,706 | Applicant(s) CONDON ET AL. | |
|---|---|---|---|
| | Examiner M Kemper | Art Unit 3622 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-16 and 18-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16, 18-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-16,18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroening et al., patent number 6080207.

Kroening et al. teaches a method and corresponding apparatus for automatically manufacturing a computer comprising: receiving an order from a customer (col. 4, lines 5-45); assembling the hardware (col. 4, lines 5-45, col. 5, lines 30-35); loading onto the computer a software package specified by the order including recording the modification as an auto-configuration file and for each modification, determining configuration data corresponding to the respective modification and entering the configuration data as the software package is loaded (col. 5, lines 15-40, col. 7, lines 10-50, col. 8, lines 5-35). Kroening also teaches verifying the modifications (col. 5, lines 15-25); downloading the order to a manufacturing unit (col. 7, lines 10-50); including an auto-configuration indicator in the order (col. 7, lines 20-30); generating a flag to look for the special configuration requirement, making an inquiry to a manufacturing database for the special configuration requirement and applying the requirement to the order (col. 7, lines 15-col. 8, line 20). Kroening does not show providing an Internet-accessible page for the customer to specify modifications, however, it would have been obvious at the time of the invention to have used an Internet accessible page since this would have been adopted for the intended use of providing customer convenience and for interfacing with

the image server (col. 6, lines 60-67). It also would have been obvious to have verified modification against order details since this would have prevented errors in the product. It also would have been obvious to have logged the modifications at least for the directory information (col. 5, lines 35-55) in order to troubleshoot. It also would have been obvious to have generated an order reference number since this would have been necessary for tracking and identification purposes for the custom computers.

3. Applicant's arguments filed on 3-10-03 have been fully considered but they are not persuasive. The applicant argues that Kroening et al., patent number 6,080,207 does not teach assembling together a selection of hardware components specified by the order. The examiner does not agree with this statement. Kroening teaches assembly of the computer system (abstract) where the bill of materials includes specifics on the computing system such as hard drive size (col. 4, lines 30-45) and where the "customer's hardware, software, and special requirements" are taken into consideration in a fresh build process (col. 7, lines 30-40). Also, the interpretation of the claim limitation would include hardware settings as those described in Kroening since the claim is not limited to any type of specification per se. The applicant also disagrees with the official notice made in the rejection, however, the applicant does not properly challenge the official notice with specific arguments.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of

any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. (MPEP 2144.03).

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

M Kemper
Primary Examiner
Art Unit 3622

mk
June 2, 2003